

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed September 11, 2003. At the time of the Office Action, Claims 1-35 were pending in the Application. Applicant amends Claims 1, 3, 8-9, 13, 15, 18-19, 23-24, 26, 29, and 31-35 to further clarify various distinguishing features already present in Applicant's claims and to correct various informalities. Duplicate Claims 14 and 15 have been cancelled and re-presented as new Claims 36 and 37. For at least the reasons discussed below, Applicant believes all of the pending claims to be allowable over the cited references. Applicant respectfully requests reconsideration and allowance of Claims 1-37.

Section 101 Rejections

The Examiner rejects Claims 24-35 under 35 U.S.C. §101, stating that the claimed invention is directed to non-statutory subject matter. Applicant has amended Claim 24 to clarify that each step of the computer-implemented method is performed using a computer system comprising one or more processing units. Applicant respectfully requests that these rejections be withdrawn.

Section 103 Rejections

The Examiner rejects Claims 1-11, 13-21, and 23-24 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,991,739 issued to Cupps ("*Cupps*") in view of U.S. Patent No. 4,971,409 issued to Hanson ("*Hanson*") and U.S. Patent No. 5,895,454 issued to Harrington ("*Harrington*"). The Examiner rejects Claims 12, 22, and 35 under 35 U.S.C. §103(a) as being unpatentable over *Cupps* in view of *Hanson* and *Harrington* as applied to Claims 1, 13, and 24 and in further view of U.S. Patent No. 4,797,818 issued to Cotter ("*Cotter*").

Cupps discloses an online ordering machine that manages the distribution of home delivered products. (*Cupps*, Abstract) The online ordering machine provides customers with product information from various vendors and accepts orders from the customers for a given product from a given vendor. (*Cupps*, Abstract) A vendor web page can be displayed to the customer based on a generalized category of a product, such as "pizza," and lists vendors who

sell that general category of product. (*Cupps*, Figure 8; Col. 9, lines 16-23) A menu web page that lists the menu items for a given vendor may also be displayed to the customer. (*Cupps*, Figure 9; Col. 9, lines 24-33) The customer can browse these web pages, select an item of interest for delivery, and receive a notification of an estimated delivery time for the item. (*Cupps*, Col. 10, lines 11-16, Col. 11, lines 24-27)

Hanson discloses a data entry terminal used by a business that is able to receive input regarding a customer order and transmit that information to a remote station. (*Hanson*, Col. 1, lines 25-64) For example, an employee of a restaurant may enter a customer order into the terminal and the terminal will transmit the ordering information to the kitchen. (*Hanson*, Col. 1, lines 25-64) A central processing system may estimate a delivery time to a customer and notify the data entry station if an unusual delay in delivery is expected. (*Hanson*, Col. 16, lines 64-68)

Harrington discloses a system and method for networking commercial transactions where a local user can conduct business with a remote vendor. (*Harrington*, Col. 2, lines 10-16) The system utilizes a hierarchical menu system to allow a local user to select a vendor in a given area of the world and further refine the search to specific countries and cities. (*Harrington*, Col. 5, lines 25-34) The system may also use a hierarchical menu system to allow a local user to select a desired category of product or service and further refine the search to a specific product or service. (*Harrington*, Col. 5, lines 35-40)

Cotter discloses a computerized order and delivery system for use by related or franchised stores. (*Cotter*, Col. 2, lines 20-23) The system may select the franchise store best able to respond to an incoming order. (*Cotter*, Col. 2, lines 23-31)

In order to establish a *prima facie* case of obviousness, three requirements must be met: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge available to one skilled in the art, to modify a reference or combine multiple references; (2) there must be a reasonable expectation of success; and (3) the prior art reference (or combination of references) must teach or suggest all of the claim limitations. M.P.E.P. § 2143. In the present case, a *prima facie* case of obviousness cannot be maintained for at least two reasons. First, neither *Cupps*, *Harrington*, *Hanson*, nor *Cotter* provides a suggestion or

motivation to combine the references. Second, even assuming for the sake of argument that the references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Cupps*, *Harrington*, *Hanson*, and *Cotter*, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, still fail to disclose all of the elements of the pending claims.

A. No Motivation or Suggestion to Combine *Cupps*, *Harrington*, *Hanson*, and *Cotter*

The M.P.E.P. sets forth a strict legal standard for finding obviousness based on a combination of references. According to the M.P.E.P., “Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge [that was] generally available to one of ordinary skill in the art” at the time of the invention. M.P.E.P. 2143.01. The “fact that references can be combined or modified does not render the resultant combination [or modification] obvious unless the prior art also suggests the desirability of the combination” or modification. *Id.* (emphasis in original).

The governing Federal Circuit case law makes this strict legal standard even more clear.¹ According to the Federal Circuit, “a showing of a suggestion, teaching, or motivation to combine . . . prior art references is an essential component of an obviousness holding.” *In re Sang-Su Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25 (Fed. Cir. 2000)). “Evidence of a suggestion, teaching, or motivation . . . may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, the nature of the problem to be solved.” *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999). However, the “range of sources available . . . does not diminish the requirement for actual evidence.” *Id.* In *In re Dembiczak*, the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences,

¹ Note M.P.E.P. 2145(X)(C) (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

explaining that proper evidence of a teaching, suggestion, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hind-sight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted).² In the present case, the Examiner is improperly using the Applicant's disclosure as a blueprint for piecing together various elements of *Cupps, Harrington, Hanson, and Cotter*. Furthermore, the Examiner has merely stated that at the time the present invention was made, it would have been obvious for one of ordinary skill in the art to combine the teachings of *Cupps, Harrington, Hanson, and Cotter*. However, even a determination that it would have been obvious to one of ordinary skill in the art at the time of the invention to try the proposed combination is not sufficient to establish obviousness. See *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

Consequently, a *prima facie* case of obviousness cannot be maintained with respect to Claims 1-37, as the Examiner has not shown the requisite proof necessary to establish a suggestion or motivation to combine the cited references. For at least this reason, Applicant respectfully requests reconsideration and allowance of Claims 1-37.

B. The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 1-37

Even assuming for the sake of argument that the cited references did suggest or motivate a combination of the references to a person of ordinary skill in the art at the time of the invention, *Cupps, Harrington, Hanson, and Cotter*, whether considered singly, in combination with one

² See also *In Re Jones*, 958 F.2d 347, 351 (Fed. Cir. 1992) (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at” the claimed invention.).

another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, would still fail to disclose each and every element of Claims 1-37.

1. **The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 1, 13, and 23-24**

Claim 1, as amended, of the present Application recites:

A system for brokering food order transactions among a plurality of unaffiliated sellers, comprising:
one or more databases containing:
delivery information associated with each of a plurality of buyers;
substantially real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers;
pricing information for the particular food items available from each unaffiliated seller; and
delivery information for each unaffiliated seller comprising a delivery area for the unaffiliated seller and substantially real-time delivery time information for the unaffiliated seller based at least in part on a current order backlog for the unaffiliated seller; and
a food order transaction broker operable to:
receive a request for at least one particular food item from a buyer;
generate a list of one or more unaffiliated sellers of the requested particular food item according to a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting the pricing information for the requested particular food item for each listed unaffiliated seller and the substantially real-time delivery time information for each listed unaffiliated seller; and
initiate a food order transaction concerning the requested particular food item with a particular listed unaffiliated seller selected from the list.

Claims 13 and 23-24, as amended, recite similar limitations.

Claim 1, as amended, recites "one or more databases containing . . . substantially real-time availability information identifying particular food items from each of a plurality of unaffiliated sellers." None of the cited references disclose this limitation. For example, *Cupps* merely discloses a menu web page that lists the menu items for a given vendor. (*Cupps*, Figure 9;

Col. 9, lines 24-33) Neither *Hanson*, *Harrington*, nor *Cotter* provides any disclosure sufficient to make up for the deficiencies of *Cupps*.

Claim 1, as amended, also recites "substantially real-time delivery time information for the unaffiliated seller based at least in part on a current order backlog for the unaffiliated seller." Claims 13 and 23-24, as amended, recite similar limitations. The Examiner states that Column 11, lines 11-12 of *Cupps* discloses delivery time being real-time and inherently includes any backlog on the part of the seller because the seller is the one providing the delivery time information. (Office Action, Page 3) However, the Examiner has not provided a basis to reasonably support the determination that a current order backlog is inherent in the disclosure of determining an expected delivery time.

"To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." M.P.E.P. § 2112; *See In re Robertson*, 49 U.S.P.Q.2d 1949, 1150-51 (Fed. Cir. 1999). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." M.P.E.P. § 2112; *Ex parte Levy*, 17 U.S.P.Q. 1461, 1464 (Bd. Pat. App. & Inter. 1990). In the present case, *Cupps* merely states that the vendor can be prompted to indicate how long an order will take to deliver and that a customer can be notified of an expected delivery time. (*Cupps*, Col. 11, lines 11-12, 24-27) However, *Cupps* fails to disclose any basis for determining the expected delivery time. Thus, the Examiner is merely relying on the *possibility* or *probability* that the delivery time information is based at least in part on a current order backlog of the seller, but the Examiner has not shown that this *necessarily* flows from *Cupps*' disclosure that a vendor can enter an expected delivery time.

Furthermore, Claim 1, as amended, recites a food order transaction broker operable to generate "a list of one or more unaffiliated sellers of the requested particular food item according to a comparison of the requested particular food item with the substantially real-time availability

information for each unaffiliated seller and a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting the pricing information for the requested particular food item for each listed unaffiliated seller and the substantially real-time delivery time information for each listed unaffiliated seller." Claims 13 and 23-24 recite similar limitations. The Examiner states that the *Cupps-Harrington* combination discloses or makes this element obvious, citing Column 5, lines 25-61 in particular. (Office Action, Page 3) However, as discussed above, none of the references discloses *substantially real-time availability information*, let alone a list of one or more sellers generated, at least in part, according to a *comparison* of a requested particular food item with the substantially real-time availability information, as recited in Claim 1 and similarly in Claims 13 and 23-24. *Harrington* merely discloses that its system for networking commercial transactions uses hierarchical menus to guide a user and not that any type of *comparisons* are used to generate a list of one or more sellers of a requested item.

For at least these reasons, a *prima facie* case of obviousness cannot be maintained with respect to amended Claims 1, 13, and 23-24 because the cited references, whether considered singly, in combination with one another, or in combination with information generally available to those of ordinary skill in the art at the time of the invention, fail to disclose each and every element of these claims. Applicant respectfully requests reconsideration and allowance of amended Claims 1, 13, and 23-24, as well as all claims that depend from these claims.

2. The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 4-5, 27-28, and 36-37

Claim 4 recites that the substantially real-time delivery time information comprises "an estimated delivery time determined based on one or more actual delivery times for the listed seller within a predetermined time period preceding the request." Claims 27 and 36 recite similar limitations. Claim 5 recites that the substantially real-time delivery time information comprises a recent actual delivery time for the listed seller. Claims 28 and 37 recite similar limitations. To the extent that the cited references disclose estimating a delivery time, none of the cited references discloses, teaches, or suggests any particular basis for the estimation, let alone that an estimated delivery time is based on either: (1) one or more actual delivery times within a

predetermined time preceding the request as recited in Claims 4, 27, and 36, or (2) a recent actual delivery time as recited in Claims 5, 28, and 37. Furthermore, the Examiner fails to point out any portion of the cited references that purportedly disclose, teach, or suggest these limitations.

For at least this additional reason, Claims 4-5, 27-28, and 36-37 are allowable over the cited references. Applicant respectfully requests reconsideration and allowance of Claims 4-5, 27-28, and 36-37.

3. **The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 6, 16, and 29**

Claim 6 recites that "the broker is further operable to rank the listed sellers according to at least the substantially real-time delivery time information for each listed seller." Claims 16 and 29 recite similar limitations. The Examiner states that *Harrington* discloses this limitation, citing Column 5, lines 25-61 in particular. (Office Action, Page 3) *Harrington* merely discloses that a user of its system may make a selection of products for a geographical region for which delivery is available in a specifically designated time frame and that the results may be displayed hierarchically. (*Harrington*, Col. 5, lines 25-34) However, the hierarchical listing of results disclosed in *Harrington* is not a *ranking* according to substantially real-time delivery time information, as recited in Claim 6 and similarly in Claims 16 and 29. Rather, the listings disclosed in *Harrington* are merely organized hierarchically, such as cities listed by their country or region and specific products listed by their product category. (*Harrington*, Col. 5, lines 32-40) Furthermore, *Harrington* merely discloses that a user may select delivery time as a criterion to obtain information about certain products or services available from various geographical areas. (*Harrington*, Col. 5, lines 25-29) *Harrington* fails to disclose, teach, or suggest *substantially real-time delivery time information*, as recited in Claim 6 and similarly in Claims 16 and 29.

For at least these additional reasons, Claims 6, 16, and 29 are allowable over the cited references. Applicant respectfully requests reconsideration and allowance of Claims 6, 16, and 29.

4. **The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 8, 18, and 31**

Claim 8, as amended, recites that "the broker is further operable to communicate to the buyer a suggested alternative particular food item available from one or more of the sellers, along with the pricing information and substantially real-time delivery time information for the alternative particular food item for each of these sellers, if the substantially real-time delivery time information for one or more of the listed sellers exceeds a threshold." Claims 18 and 31, as amended, recite similar limitations. Citing Column 5, lines 4-9, the Examiner states that *Harrington* discloses that its system provides alternatives to a customer, and as such, it would have been obvious to a person of skill in the art to communicate the real-time delivery time to the customer so that delivery time could be used by the customer as criteria for determining which particular food item to order. (Office Action, Page 4) *Harrington*, Column 5, line 61 to Column 5, line 9, merely discloses that its system can implement user preferences to direct the user to appropriate vendor sites based on the user preferences. *Harrington* fails to disclose, teach, or suggest communicating a *suggested alternative particular item* available from one or more of the sellers, *if the substantially real-time delivery time information for one or more of the listed sellers exceeds a threshold*, as recited in Claim 8, as amended, and similarly in Claims 18 and 31, as amended.

For at least this additional reason, Claims 8, 18, and 31, as amended, are allowable over the cited references. Applicant respectfully requests reconsideration and allowance of amended Claims 8, 18, and 31.

5. **The Cited References Fail to Disclose, Teach, or Suggest Each and Every Element of Claims 9, 19, and 32**

Claim 9, as amended, recites that "the substantially real-time availability information for at least one of the sellers comprises substantially real-time availability information reflecting a current shortage of one or more particular food items normally available from the seller." Claims 19 and 32, as amended, recite similar limitations. As discussed above with respect to Claim 1, the cited references fail to disclose *substantially real-time availability information*. Furthermore, the Examiner does not point out, nor do the cited references contain, any disclosure, teaching, or

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suggestion of availability information reflecting *a current shortage of one or more particular food items normally available from the seller*, as recited in Claim 9, as amended, and similarly in Claims 19 and 32, as amended.

For at least this additional reason, Claims 9, 19, and 33, as amended, are allowable over the cited references. Applicant respectfully requests reconsideration and allowance of amended Claims 9, 19, and 32.

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CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Christopher W. Kennerly, Attorney for Applicants, at the Examiner's convenience at (214) 953-6812.

The required fee of \$420.00 is submitted herewith for a two-month Extension of Time for responding to the Examiner's Office Action. Applicant believes no other fees are due. However, if this is not correct the Commissioner is hereby authorized to charge additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker & Botts, L.L.P.

Respectfully submitted,

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